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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,959	09/15/2005	Colin Campbell Marshall Moore	DUMMc58.001APC	4784

20995 7590 12/26/2006  
KNOBBE MARTENS OLSON & BEAR LLP  
2040 MAIN STREET  
FOURTEENTH FLOOR  
IRVINE, CA 92614

EXAMINER
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GILBERT, SAMUEL G

ART UNIT	PAPER NUMBER
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3735

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	12/26/2006	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 12/26/2006.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
eOAPilot@kmob.com

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# Office Action Summary

Application No.

10/520,959

Applicant(s)

MOORE, COLIN CAMPBELL  
MARSHALL

Examiner

Samuel G. Gilbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-9 and 15-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-8 is/are allowed.
- 6) ☒ Claim(s) 1,2,9 and 15-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/13/2006.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Information Disclosure Statement***

The information disclosure statement filed 3/13/2006 has been considered.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Alter (Penile Enlargement Surgery).

Applicant's attention is invited to page 73 "technique" to page 74, results. The post-operative regime is set forth in the last paragraph of that section.

Claims 1, 2 and 9 are rejected under 35 U.S.C. 102(b) as anticipated by Moore (AU-B-53864/98) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Moore (AU-B-53864/98) in view of Alter (Penile Enlargement Surgery).

Claims 1 and 2 - Moore teaches a method as claimed but does not set forth a postoperative regime, applicant's attention is invited to the claims of Moore. While

Moore does not set forth a postoperative regime it is the examiner's position that the surgical procedure has a postoperative regime which would include at least checking and changing the dressing as applied, page 6 lines 8-11 and follow-up visits to the operating surgeon to monitor the effectiveness of the surgery and the healing process. The applicant claims set forth no specific limitations required for the postoperative regime therefore it is the examiner's position that any postoperative activities would be covered by the claimed regime, even if it is resting for a specific amount of time.

Claim 9 - applicant's attention is invited to claim 1.

Claims 15-25 are rejected under 35 U.S.C. 102(b) as anticipated by Moore (AU-B-79900/98) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Moore (AU-B-79900/98) in view of Alter(Penile Enlargement Surgery).

Claims 15-25 - Moore teaches a method as claimed but does not set forth a postoperative regime, applicant's attention is invited to the claims of Moore. While Moore does not set forth a postoperative regime it is the examiner's position that the surgical procedure has a postoperative regime which would include at least checking and changing the dressing as applied, page 9, penultimate line, and follow-up visits to the operating surgeon to monitor the effectiveness of the surgery and the healing process. The applicant claims set forth no specific limitations required for the postoperative regime therefore it is the examiner's position that any postoperative

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activities would be covered by the claimed regime, even if it is resting for a specific amount of time.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore (AU-B-53864/98) in view of Alter (Penile Enlargement Surgery).

If however the claimed regime is not inherent in the teaching of Moore it would have been obvious in view of Alter (Penile Enlargement Surgery). Alter teaches a penile widening and lengthening procedure including a post operative regime of applying weights to the penis, page 72, column 2 in the results paragraph. The postoperative regime is required to maintain length gain. It would have been obvious to one of ordinary skill in the medical arts at the time the invention was made to include a post operative regime of applying weights to the penis to maintain the length gain as set forth by Alter. Combined length and girth surgery provide a more complete penis

enlargement as is well known in the art and desired by many of those seeking phalloplasty.

Claims 15-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore (AU-B-79900/98) in view of Alter (Girth Enhancement).

If however the claimed regime is not inherent in the teaching of Moore it would have been obvious in view of Alter(Girth Enhancement).

Alter teaches a penile widening procedure including a post operative care including dressing removal, page 1 penultimate paragraph which require the patient to remain local for about a week.. The postoperative regime is required for proper care. It would have been obvious to one of ordinary skill in the medical arts at the time the invention was made to include a post operative regime of remaining local for about a week to allow for proper care as set forth by Alter.

#### ***Allowable Subject Matter***

Claims 4-8 are allowed.

#### ***Conclusion***

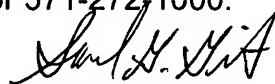
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patents 6,173,714 and 5,921,246 teach related methods for enlarging a penis.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G. Gilbert whose telephone number is 571-272-4725. The examiner can normally be reached on Monday-Friday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor II can be reached on 571-272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Samuel G. Gilbert  
Primary Examiner  
Art Unit 3735

sgg